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PATENT
Atty. Dkt. No. SEDN/5915

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Hendricks, et al.

Serial No.: 09/396,428

Confirmation No.: 7433

Filed: September 15, 1999

For: TELEVISION TERMINAL DATA
STORAGE

§ Case Number: 5915
§
§ Group Art Unit: 2623
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§ Examiner: Lonsberry, Hunter B.
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8/29/07
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C. Wilson
C. Wilson

Dear Sir or Madam:

REPLY BRIEF

Appellants submit this Reply Brief to the Board of Patent Appeals and Interferences in response to the Examiner's Answer dated July 2, 2007 in the Appeal of the above-identified application.

The Commissioner is authorized to charge any fees due, including extension of time and excess claim fees, to counsel's Deposit Account No. 20-0782/SEDN/5915.

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REMARKS

In Section 10 of The Examiner's Answer (Response to Arguments), the Examiner asserts that it would not be apparent to one skilled in the art, at the time of filing the application, how to make a connection between the set top terminal and the hardware upgrade to transmit audio and video data. Essentially, the Examiner asserts that the priority document does not fully enable the Appellants' invention. (See Examiner's Answer, p. 23, ll. 2-4).

Under 35 U.S.C. §112, paragraph 1, the applicant is required to satisfy the written description and enablement requirements. The relevant portion of the statute requires that "the specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Notably, the written description and enablement requirement generally requires the applicant to describe the invention to one of ordinary skill in the art. The Court has held that "[n]ot every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." *In re Gay*, 309 F.2d 769, 135 USPQ 311, 316 (C.C.P.A. 1962).

The Appellants respectfully submit that it would be apparent to one skilled in the art, at the time of filing the application, how to make a connection between the set top terminal and the hardware upgrade to transmit audio and video data. The priority document clearly provides the necessary link between the simple decompression box and a set top terminal to one of ordinary skill in the art. (See priority document, p. 57, ll. 8-10.) Irrespective of what specific functions are missing, since a simple decompression box and a set top terminal are similar, one of ordinary skill in the art would know how to integrate various functions of the simple decompression box into a set top terminal and vice versa.

Moreover, the priority document clearly discloses the limited options for providing the connection between the set top terminal and the hardware upgrade to transmit audio and video data. As stated in the appeal brief, the priority document teaches an

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interface for communicating video signals. Specifically, the priority document teaches that "hardware upgrade port 662 should accommodate at least a four-wire connection for... (3) decompressed video output... and (4) video input port." (See e.g., priority document, p. 54, ll. 1-9). Thus, the specification of the priority document explicitly discloses and supports an interface for communicating video signals between the set top terminal and the hardware upgrade. Therefore, the Appellants' respectfully submit that the priority document fully enables the Appellants' invention of the present application to one of ordinary skill in the art and that the present application should be afforded the priority date of the priority document, i.e. December 29, 1992.

In summary, the Appellants maintain that neither the Florin reference, filed June 22, 1993, nor the Granger reference, filed December 15, 1992, are prior art against claim 1, because these references have priority dates after the priority date of the Appellants' independent claims. Furthermore, Graczyk fails to teach or suggest Appellants' invention as a whole and therefore do not render obvious the Appellants' independent claims. Therefore, the Appellants respectfully request the Board to reverse the Examiner's rejection of all claims.

CONCLUSION

Appellants respectfully request that the Board reverse the rejections and pass the claims to allowance.

Respectfully submitted,



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